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No. 02-1008

In The

# Supreme Court of the United States

NARTON CORPORATION,

*Petitioner,*

v.

STMICROELECTRONICS, INC.,

*Respondent.*

**On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Sixth Circuit**

## BRIEF IN OPPOSITION

BUTZEL LONG
PHILIP J. KESSLER
*Counsel of Record*
JAMES E. STEWART
LAURIE J. MICHELSON
150 W. Jefferson, Suite 900
Detroit, MI 48226
(313) 225-7000

THOMPSON & KNIGHT L.L.P.
BRUCE S. SOSTEK
JANE POLITZ BRANDT
1700 Pacific Avenue
Suite 3300
Dallas, TX 75201-4693
(214) 969-1700

*Counsel for Respondent*

COCKLE LAW BRIEF PRINTING CO (800) 225-6964
OR CALL COLLECT (402) 342-2831

## QUESTIONS PRESENTED

1. Should this summary judgment case be reviewed on a writ of certiorari where none of the considerations in Supreme Court Rule 10 governing such review are present (*i.e.*, no circuit split, no conflict with any other decision, and no departure from the accepted and usual course of judicial proceedings), as the sole contention of Petitioner Nartron Corporation ("Nartron") is that it disagrees with the court of appeals' conclusion that no material issue of fact exists on its trademark and unfair competition claims, and granting the Petition would not affect the grant of summary judgment as Nartron is not challenging the ruling on the separate and independent defense of laches?

2. Did the court of appeals correctly affirm the grant of STMicroelectronic, Inc.'s ("ST") renewed motion for summary judgment where ST presented undisputed evidence from virtually every source identified by the case law that "smart power" is generic in the semiconductor industry – articles, books, newspapers, advertisements, conference materials, dictionaries, third party use, patents, and trademarks – and Plaintiff failed to present *any* evidence from the semiconductor industry that "smart power" denotes Nartron?

TABLE OF CONTENTS


| | Page |
|---|---|
| QUESTIONS PRESENTED | i |
| TABLE OF CONTENTS | ii |
| TABLE OF AUTHORITIES | iv |
| CONSTITUTIONAL PROVISIONS, TREATIES, STATUTES, ORDINANCES, AND REGULATIONS INVOLVED IN THE CASE | 1 |
| STATEMENT OF THE CASE | 1 |
| A. Overview | 1 |
| B. Statement of Facts | 3 |
| 1. The Parties | 3 |
| 2. The Expanded Summary Judgment Record: "Smart Power" is Generic in the Semiconductor Industry | 4 |
| 3. ST's Use of "Smart Power" | 5 |
| C. Procedural History/Opinions Below | 7 |
| D. Summary of Bases for Denying Writ | 11 |
| ARGUMENT | 13 |
| A. Nartron's Contentions For Seeking Review On Certiorari Are Fundamentally Flawed | 13 |
| 1. The Court of Appeals Correctly Applied the Law of Summary Judgment | 13 |
| 2. A Grant of a Renewed Motion for Summary Judgment is Proper | 16 |
| a. The Chronology | 18 |
| b. Undisputed testimony from representatives of the semiconductor industry | 19 |

TABLE OF CONTENTS – Continued

Page

c. Materials pertaining to ST's VIPower® products ..... 21

B. ST Was Entitled To Summary Judgment Because There Was No Genuine Issue Of Material Fact As To Whether "Smart Power" Is Generic ..... 21

1. Summary Judgment Standard ..... 21

2. ST Satisfied its Burden of Establishing that "Smart Power" is Generic in the Semiconductor Industry ..... 22

3. Nartron's Criticisms of the Sixth Circuit's Ruling Have No Merit ..... 25

CONCLUSION ..... 28

## CORPORATE DISCLOSURE STATEMENT

Respondent STMicroelectronics, Inc. is a wholly owned subsidiary of STMicroelectronics, N.V.

## TABLE OF AUTHORITIES

Page

CASES

*Ale House Management, Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137 (4th Cir. 2000) ..... 16

*Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986) ..... 13, 14, 21, 22

*Celotex Corp. v. Catrett*, 477 U.S. 317 (1986) ..... 21, 26

*CES Publ'g Corp. v. St. Regis Publ'g*, 531 F.2d 11 (2d Cir. 1975) ..... 23

*City Management Corp. v. U.S. Chemical Co.*, 43 F.3d 244 (6th Cir. 1994) ..... 13

*Danjaq v. Sony*, 263 F.3d 942 (9th Cir. 2001) ..... 12

*Dessar v. Bank of Am. Nat'l Trust & Sav. Ass'n*, 353 F.2d 468 (9th Cir. 1965) ..... 17

*Dictograph Prods. Co. v. Sonotone Corp.*, 230 F.2d 131 (2d Cir. 1956) ..... 17

*Frito-Lay, Inc. v. Bachman*, 704 F. Supp. 432 (S.D.N.Y. 1989) ..... 24

*Gulezian v. Drexel Univ.*, 1999 U.S. Dist. LEXIS 4626 (E.D. Pa. 1999) ..... 16

*In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987) ..... 23

*Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 2002 WL 1163624 (9th Cir. 2002) ..... 12

*Kovacevich v. Kent State Univ.*, 224 F.3d 806 (6th Cir. 2000) ..... 18

*Liquid Controls Corp. v. Liquid Control.*, 802 F.2d 934 (7th Cir. 1986) ..... 16, 24, 27

TABLE OF AUTHORITIES – Continued

Page

*Maine Avenue Seafood, Inc. v. The Crab House, Inc.*, 1998 U.S. Dist. LEXIS 23144 (D. Md. 1998) .....16

*Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574 (1986) .....22

*Messenger v. Anderson*, 225 U.S. 436 (1912) .....17

*Miller Brewing Co. v. G. Heileman Brewing Co.*, 56 F.2d 75 (7th Cir. 1977) .....27

*Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397 (6th Cir. 2002) ..... 8

*National Conf. of Bar Examiners v. Multistate Legal Studies*, 692 F.2d 478 (7th Cir. 1982) .....27

*Nestle Co. v. Chester's Market*, 571 F. Supp. 763 (D. Conn. 1983) .....16, 23

*Perez-Ruiz v. Crespo-Guillen*, 25 F.3d 40 (1st Cir. 1994) .....17

*Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp.2d 286 (S.D.N.Y. 2000) .....23

*S Indus., Inc. v. GMI Holdings*, 1998 U.S. Dist. LEXIS 1780 (N.D. Ill. 1998) .....26

*Technical Publishing Co. v. Lebhar-Friedman, Inc.*, 729 F.2d 1136 (7th Cir. 1984) .....27

*Whitford v. Boglino*, 63 F.3d 527 (7th Cir. 1995) .....17

OTHER AUTHORITIES

FED. R. CIV. P. 56 ..... 1, 3, 12, 13, 21

## CONSTITUTIONAL PROVISIONS, TREATIES, STATUTES, ORDINANCES, AND REGULATIONS INVOLVED IN THE CASE

None. As Nartron's Petition makes clear, this case only involves a straight-forward application of FEDERAL RULE OF CIVIL PROCEDURE 56 construed in accordance with existing United States Supreme Court precedent and consistent court of appeals' decisions. Pursuant to this rule, "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits . . . show[ed] that there is no genuine issue as to any material fact and that the moving party [was] entitled to judgment as a matter of law." In determining that ST was entitled to summary judgment under this rule, the court of appeals obviously had to consider the evidence presented – as does every court considering a summary judgment motion. This did not constitute "impermissible weighing" of the evidence. Nor could it have since Nartron presented no rebutting evidence to weigh.

## STATEMENT OF THE CASE

### A. Overview

This unremarkable trademark case is wholly unsuited for certiorari review. Nartron's Petition glaringly fails to meet any of the standards supporting the issuance of a writ. Nartron's Petition simply challenges the grant of summary judgment in favor of the Defendant in a trademark infringement case on genericness.

The Petition is based on the factually and legally erroneous premise that because the district court denied ST's initial motion for summary judgment on the issue of genericness, it was somehow improper to later grant ST's Renewed Motion for Summary Judgment based in part on that same defense. The key point with which Nartron

failed to deal below and in its Petition, however, is that when the district court subsequently dismissed Nartron's trademark infringement and unfair competition claims based on genericness (and laches),[1] it did so on a far more developed and corrected record that indisputably demonstrated ST's entitlement to summary judgment. Indeed, the district court's decision was required by the undisputed fact that, in the semiconductor industry, the term "smart power" is generic.

The undisputed record upon which both the district court and Sixth Circuit based their decisions showed that for nearly 20 years, the semiconductor industry has consistently used the term "smart power" to denote a type of integrated circuit that combines both power and logic on a single microchip. The term does not denote any manufacturer. Essentially this technology involves a semiconductor that can control power (electricity) while also using logic circuitry to protect itself against disturbances such as excess heat, over-voltage, or shorted load.

Like virtually everyone in the semiconductor industry, for many years ST has used "smart power" to denote this type of technology. In this litigation, Nartron singled out ST and claimed that ST's reference to "smart power" (although in combination with ST trademarks) infringed Nartron's SMART-POWER mark. To support its Renewed Motion for Summary Judgment on genericness, ST developed a record which conclusively demonstrated the decades-long, pervasive industry use of "smart power" –

[1] It is noteworthy that Nartron does not challenge the Sixth Circuit's affirmance of the district court's grant of summary judgment in ST's favor on laches based on Nartron's 11-year delay in bringing its suit. Thus, even if this Court reviewed the Sixth Circuit's decision – and reversed it on genericness – the summary judgment would remain.

resulting in a 150-page Chronology detailing this use. ("ST's Chronology"). Plaintiff did not and could not rebut ST's Chronology.

Accordingly, after properly analyzing and considering this much more detailed record, the district court held that there was no material issue of fact in dispute and that ST was entitled to judgment as a matter of law. The Sixth Circuit agreed. Both courts' analysis of the evidence, mandated by FED. R. CIV. P. 56, appropriately satisfy the analysis every federal court must engage in when deciding a summary judgment motion. Nartron's attempt to characterize the lower courts' conduct as an impermissible weighing of evidence, or as choosing one side's evidence over the other, is inapt. In addition, and perhaps of even greater importance, is the fact that Nartron's unsupported challenge falls woefully short of satisfying this Court's Rule 10 requirements for certiorari review.

## B. Statement of Facts

### 1. The Parties

ST, a United States company headquartered in Carrollton, Texas, competes with numerous companies such as Motorola, International Rectifier, Harris, and Siliconix in the manufacture and supply of semiconductors or "microchips." (JA 360).[2] Over the years, like many of these competitors, ST has manufactured products that combine power and intelligence on a single integrated circuit chip. ("IC").[3] (*Id.* at 146, 152). This combination of power and

[2] "JA" citations refer to the Joint Appendix filed in the court of appeals.

[3] "IC" is an industry abbreviation for "integrated circuit."

logic on a single IC has for many years been referred to by the semiconductor industry as "smart power."

Nartron, headquartered in Reed City, Michigan, does not manufacture semiconductors. Indeed, Nartron is not a manufacturer. Instead, it buys components and assembles them into "kits." (*Id.* at 843). Nartron is not a direct competitor of ST in the semiconductor industry. (*See, e.g.*, JA 377, 829). In 1982, Nartron obtained a federal trademark registration for SMART-POWER for "electrical relay assemblies in combination with electrical logic components and parts thereof." (*Id.* at 90). In 1986, Nartron broadened the identification of its goods to "electrical power circuits in combination with electrical logic circuits and parts thereof."

### 2. The Expanded Summary Judgment Record: "Smart Power" is Generic in the Semiconductor Industry

As ST's Chronology comprehensively detailed, for at least 20 years the semiconductor industry has used the term "smart power" to denote products or devices that combine logic and power – particularly semiconductor integrated circuits that combine power and logic on the same chip.

The industry's use of "smart power" is so wide-spread and pervasive that ST's most difficult problem was presenting its enormous volume of industry usage evidence in a manageable format for the district court. The format ST selected was its 150-page Chronology which played an important part in its Renewed Motion for Summary Judgment. (JA 652-817). ST's Chronology was the result of extensive "smart power" usage research performed by ST's counsel and undertaken with leave of court after the district court's initial denial of summary judgment. (*Id.* at 650-651).

ST's Chronology collected and detailed from publicly available sources the generic uses of "smart power" from as far back as 1982 through mid-2000. The expanded record on ST's Renewed Motion for Summary Judgment included over 60 engineering conferences and symposia at which "smart power" was either a specific discussion topic or the subject of a published article (*e.g., Smart Power: Testing Challenges / Effective Solutions*) (JA 679); *hundreds* of additional articles in the trade press that used the term to refer to integrated circuits that combine logic and power, as well as to the technology embodied in the integrated circuits (*e.g., SmartPower: Its Time Has Come*) (JA 930); published advertisements for several companies' "smart power" products (*e.g.*, "Harris smart power is the perfect synthesis of power and intelligence. . . .") (JA 1021); dozens of patents that used the term to refer to technology which combines logic and power (*e.g.*, "smart power devices combine power and logic devices on the same IC substrate") (JA at 734); and the unrebutted testimony of numerous representatives from the semiconductor industry regarding their use of "smart power" as the generic term for an IC that combines logic and power on a single chip. *See infra* at 19-20.[4]

### 3. ST's Use of "Smart Power"

Like the rest of the industry, ST has only used the term "smart power" to refer generally to "technology that combines power transistors and control circuiting on a single IC." (JA 173-175). Since at least 1988, ST has

[4] These uses further make clear that "smart power" describes the actual technology and does not simply describe a characteristic of the technology. In other words, "smart power" is the "item."

manufactured and marketed products that contain integrated circuits which combine power circuits and logic circuits. ST's VIPower® products are illustrative of products that utilize or embody this "smart power" technology. ST has, for example, described certain of its VIPower® products as follows:

> "The VIPower M0 process is a vertical smart power technology that allows a rugged power stage to be combined with on-chip analogue and digital circuitry." (JA 883)

ST uses its federally registered trademark VIPower® – as well as its company name – to clearly inform the reader that *ST* is the source of VIPower® products. (JA 1160-1161).

Even though Nartron indisputably had knowledge of repeated instances of ST's uses of "smart power" dating back to 1987, Nartron waited until 1998 to sue. At that time, Nartron alleged that three print advertisements "typify" ST's use of "smart power." Two of the advertisements were created by ST and used only in 1995 as part of a corporate image campaign prepared by ST's parent company. (JA 253). ST plainly did not use "smart power" to denote the source of its goods in the advertisements. To the contrary, since these were ST advertisements designed to promote ST and some of its products, the advertisements prominently display the ST trademark and begin with the sentence, "We're SGS-Thomson Microelctronics." The text of the first advertisement references "Smart Power ICs" and "smart power chips." (JA 37). The text of the second advertisement also refers to "Smart Power chips" and states that "when it comes to Smart Power, more companies count on us than any other chip manufacturer in the world." (*Id.* at 38). "Smart Power" is unquestionably being used to identify a type of technology and not a production source.

The third advertisement was prepared by one of ST's distributors, Nu Horizons Electronics Corp., in March 1996. (JA 254). This advertisement also prominently displays the ST trademark and uses the industry jargon "smart power" to denote the technology. (*Id.* at 39).

Both the district court and the Sixth Circuit correctly determined that the semiconductor industry's pervasive uses of "smart power" in its generic sense (including ST's uses) extinguished any trademark rights in Plaintiff's SMART-POWER mark. As a result, ST was entitled to summary judgment on Nartron's claims.

### C. Procedural History/Opinions Below

1. On September 20, 1999, after Nartron had filed a motion to dismiss certain of ST's affirmative defenses, ST initially moved for summary judgment on Nartron's claims. On January 6, 2000, the district court entered an Order denying ST's Motion and granting in part Nartron's Motion by dismissing ST's affirmative defenses of laches and equitable estoppel. (JA 477).

Thereafter, Nartron sought to broaden its Complaint by alleging that its trademark infringement claims included claims based on ST's use of the words "smart power" in connection with ST's separately trademarked VIPower® products. On March 3, 2000, ST filed a Motion to Dismiss for Lack of Subject Matter Jurisdiction Claims Regarding VIPower® Products and/or to Amend the Scheduling Order. ST argued that Nartron had never asserted a specific claim of infringement as to VIPower® products, and thus, those products were not properly part of the case. ST argued alternatively, that if the court was to allow Nartron to pursue claims based on VIPower® products, then the parties should be permitted to take discovery on these products.

The district court declined at that time to dismiss the claims, but gave the parties additional time to conduct discovery on VIPower®. (JA 1311). The Court also reinstated ST's laches defense[5] and provided the parties an opportunity to file motions for summary judgment on these issues at the conclusion of discovery.

2. On July 7, 2000, pursuant to the district court's Order, ST filed its Renewed Motion for Summary Judgment. This Motion was supported by ST's 150-page Chronology (JA 652-817) that included hundreds of additional examples of the semiconductor industry's generic use of the term "smart power" that had not been before the court during the initial summary judgment arguments. The court heard extensive oral argument on September 18, 2000 and granted summary judgment in favor of ST based on laches and genericness. (JA 1409). In response to repeated inquiries from the district court, Nartron was unable to identify any evidence to rebut ST's Chronology or to demonstrate that the semiconductor industry associated "smart power" with Nartron. (JA 1397-1400). The court thereafter correctly determined: "[N]ow on genericness. I think a good showing has been made enough to render the fact undisputed, particularly when ignorance is all that the plaintiff offers the Court. A good showing has been made that Smart Power became a generic term over the 20 years of use in the industry." (Pet. App. at 33a).

3. The Sixth Circuit affirmed the grant of ST's Renewed Motion for Summary Judgment. *Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397 (6th Cir. 2002) (Pet. App. at Appendix A). After setting out the proper summary

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[5] The court reinstated ST's laches defense upon learning that Nartron's counsel had provided certain misinformation to the Court during the initial summary judgment arguments in 1999.

judgment standard, the court began its genericness analysis with the following conclusion:

> The district court correctly granted summary judgment in favor of ST on the issue of genericness of the term "smart power" as used in the semiconductor industry in connection with ST's products, including ST's VIPower® line of products. In opposing ST's summary judgment motion on the issue of genericness, Nartron failed to present evidence demonstrating any genuine issue of material fact.

(Pet. App. at 9a). In support of this conclusion, the court first considered the difference between a "generic term" and one that is "merely descriptive." The court recognized that while a mark's incontestable status does not protect it from a challenge that it has become generic, the burden is on the defendant to overcome the presumption that the term is non-generic. Obviously, the only way for the appellate court to determine whether the defendant has met this burden is to consider the evidence in the record below. Here, after carefully considering the record, the Sixth Circuit held that:

> In addition to demonstrating the absence of any genuine issue of material fact on its claim of genericness, ST also produced sufficient evidence to overcome whatever presumption of non-genericness Nartron was entitled to on account of its ownership of an incontestable federally registered trademark. We reject Nartron's arguments urging that we reach a contrary conclusion.

(*Id.* at 13a).

Notably, the Nartron arguments that the Sixth Circuit carefully considered and rejected are precisely the same arguments Nartron has again raised in its Petition. Nartron argued in the court of appeals that in granting ST's motion for summary judgment, the district court

improperly made inferences in ST's favor and improperly weighed evidence in concluding that "smart power" was generic, because ST presented no survey or dictionary definition and its Chronology only showed that "smart power" was merely descriptive (and not generic). This Court should not revisit this identical allegation of "impermissible weighing" of evidence that Nartron is now leveling against the court of appeals.[6] The Sixth Circuit expressly determined that Nartron's arguments were without merit because:

- "the overwhelming evidence in this case [consisting of the undisputed testimony from third-party participants in the semiconductor industry and sources contained in the Chronology] obviates the need for ST to have conducted a consumer survey. . . . This result is compelled where Nartron has failed to rebut the proffered evidence, nor presented evidence of its own suggesting that there is a genuine issue of material fact with respect to the issue of genericness."
- "Dictionary definitions are merely one source from which genericness may be proven. The law is quite clear that the absence of a composite term from the dictionary does not end the analysis, because numerous terms have been found to be generic despite their absence from the dictionary;" and
- "Nartron fails to appreciate the distinction between 'common descriptive' terms [*i.e.*, generic terms] and terms considered 'merely descriptive.' Some terms on ST's list . . . suggest that

[6] Notably, Nartron did not seek a rehearing or *en banc* consideration by the Sixth Circuit.

> 'smart power' was being used descriptively. The majority of the examples, however, clearly demonstrate that, as used in the semiconductor industry, 'smart power' was used as a designation of the article itself – here, a wide range of products and technologies all of which implement the function of interfacing logic circuits to power loads."

(Pet. App. at 16a-18a).

On virtually every page of its genericness ruling, the Sixth Circuit made reference to the standard that must be met for summary judgment and the reasons it believed ST satisfied those standards. The court went out of its way to ensure a thorough, appropriate analysis of the record and applied recognized principles of summary judgment and trademark law in a clear, straightforward manner, obviating any need for this Court to reconsider the ruling.

### D. Summary of Bases for Denying Writ

Nartron's primary allegation of error is that the "district court and the Sixth Circuit necessarily improperly weighed evidence in granting and affirming summary judgment [on] genericness." (Pet. App. at 10). Such an allegation hardly warrants certiorari review.

First: There is little practical reason for the Court to review this case. Even a reversal on genericness would not affect the ultimate outcome, since summary judgment was also granted on the separate and distinct defense of laches – which Nartron is not challenging.[7]

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[7] Moreover, despite Nartron's contention to the contrary, a ruling on laches does not only preclude an award of past damages. Several recent cases have recognized that where, as here, there would be significant prejudice to the defendant, even prospective relief is

(Continued on following page)

Second: Nartron's allegation of error does not satisfy the stringent requirements of Supreme Court Rule 10. This case does not involve an issue of national importance or even one of constitutional interpretation. Nor does it conflict with the decision of any other court. To the contrary, the Sixth Circuit's decision is entirely consistent with the wealth of case law in which the federal courts have found a trademark to be generic as a matter of law after considering the record evidence. Moreover, the Sixth Circuit did not depart in any way from "the accepted and usual course of judicial proceedings . . . as to call for an exercise of this Court's supervisory power." (Supreme Court Rule 10). Again, this case involves a straightforward application of FED. R. CIV. P. 56, the corresponding summary judgment principles mandated by this Court, and the relevant, recognized trademark law.

Third: A grant of summary judgment on the issue of genericness was the only proper ruling given the undisputed record before the courts below. The painstakingly thorough, undisputed record on genericness was confirmed by ST's Chronology, which detailed a 20-year history of the semiconductor industry's pervasive, continuous use of "smart power" to describe an integrated circuit that combines power and logic. ST's Chronology presented undisputed evidence from virtually every appropriate source identified in the case law that "smart power" is generic in the semiconductor industry – articles, books, newspapers, advertisements, conference materials, dictionaries, third party use, patents, and trademarks. *See, e.g.,* Pet. App. at 15a (citing cases). To be stressed is that

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precluded. *See, e.g., Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 2002 WL 1163624 (9th Cir. 2002); *Danjaq v. Sony*, 263 F.3d 942 (9th Cir. 2001).

Nartron failed to present *any* evidence from the semiconductor industry that "smart power" denotes Nartron – or, for that matter, any other source or sources. Instead, Nartron simply and inaccurately mischaracterized ST's Chronology as an "unstructured amalgam of occasional third party uses" (JA 1164-1193) – an unfounded criticism entirely refuted by the contents of the Chronology.

## ARGUMENT

### A. Nartron's Contentions For Seeking Review On Certiorari Are Fundamentally Flawed

#### 1. The Court of Appeals Correctly Applied the Law of Summary Judgment

Nartron's contention that the Sixth Circuit engaged in "impermissible weighing" of evidence reflects a fundamental misunderstanding of the law of summary judgment and badly mischaracterizes the court's opinion.

On its face, the court of appeals' opinion makes clear that it applied the appropriate summary judgment standard as set forth in FED. R. CIV. P. 56 and the summary judgment standards set forth by this Court and the Sixth Circuit. The court began its legal analysis with an express recognition that:

> Summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *City Management Corp. v. U.S. Chemical Co.*, 43 F.3d 244, 250 (6th Cir. 1994). We consider all facts and inferences drawn therefrom in the light most favorable to the non-moving party. *Id. The central inquiry is "whether the evidence presents a sufficient disagreement to require submission to a jury, or whether it is so one-sided that one party must prevail as a matter of law." Anderson v. Liberty Lobby, Inc.*, 477 U.S.

> 242, 251-52 (1986). Nevertheless, the mere scintilla of evidence in support of the non-movant's position is not sufficient to create a genuine issue of material fact. *Id. The proper inquiry is whether the evidence is such that a reasonable jury could return a verdict for the non-movant. Id.*

(Pet. App. at 8a-9a) (emphasis added).[8] Nartron is not challenging the *Liberty Lobby* framework. The "inquiries" mandated by this case in deciding a motion for summary judgment – *i.e.*, "whether the evidence presents a sufficient disagreement to require submission to a jury, or whether it is so one-sided that one party must prevail as a matter of law" and/or "whether the evidence is such that a reasonable jury could return a verdict for the non-movant" – necessitate an analysis and consideration of the evidence presented by the parties.

Nartron's efforts to recast the term "weighing" as a pejorative, so as to suggest that the Sixth Circuit improperly invaded the province of the jury, is simply incorrect. In making its required "inquiries" to determine whether a reasonable jury could find for Nartron on its trademark infringement claim, the Sixth Circuit simply examined the record before it. The record consisted of ST's undisputed testimony from numerous third-party participants in the semiconductor industry as well as an unrebutted and overwhelming volume of evidence in its Chronology from trade journals, newspapers, other publications, advertisements, patents, trademarks, and copyright registrations that "smart power" was generic. Nartron's alleged "rebuttal evidence" was merely the self-serving, conclusory testimony of Nartron's President and a single trade journal editorial that was not inconsistent with the

[8] Emphasis added throughout unless otherwise indicated.

Chronology, and even warned that "smart power" was at risk of becoming generic. Confronted with this record, the Sixth Circuit correctly found that:

> Here, on its summary judgment motion for genericness, ST sufficiently carried its burden of demonstrating the absence of any genuine issue of material fact on its claim of genericness. ST produced overwhelming evidence, which Nartron failed to rebut, that the term "smart power," as used by ST and other participants in the semiconductor industry, denotes a type of technology, not goods associated with Nartron. We are not convinced by Nartron's argument that the district court improperly applied the summary judgment standard. Nor are we persuaded by Nartron's specious arguments that there remain genuine issues of material fact which should have precluded the district court's grant of ST's summary judgment motion.

(*Id.* at 12a). This court should be equally unconvinced that the court of appeals "improperly applied the summary judgment standard."[9]

If anything, the Sixth Circuit's ruling is entirely consistent with numerous other cases in which federal courts have granted summary judgment on the issue of genericness after analyzing evidence from the "relevant

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[9] On pages 17-18 of its Petition, Nartron quotes a passage from the Sixth Circuit opinion summarizing the undisputed evidence provided by ST. The Sixth Circuit goes on to conclude that this "overwhelming evidence . . . obviates the need for ST to have conducted a consumer survey." *Id.* This does not demonstrate that the Sixth Circuit improperly "weighed evidence." The court was merely rejecting Nartron's contention that the absence of a survey precluded summary judgment because, in relying on other sources, ST had more than adequately presented evidence from the relevant public.

public." *See, e.g., Ale House Management, Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137 (4th Cir. 2000) (after considering extensive evidence, including citations to newspapers, dictionaries, books and other publications, court found "ale house" generic as a matter of law for a facility that serves beer and ale); *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934 (7th Cir. 1986) (after considering dictionary definitions of terms "liquid" and "controls" and three patent applications, court found "Liquid Controls" generic as a matter of law for devices to measure and control liquids); *Maine Avenue Seafood, Inc. v. The Crab House, Inc.*, 1998 U.S. Dist LEXIS 23144 (D. Md. 1998) (after considering large numbers of newspaper articles, registrations and telephone book entries, court found "crab house" generic as a matter of law); *Nestle Co. v. Chester's Market*, 571 F. Supp. 763 (D. Conn. 1983) (after considering evidence such as surveys, dictionaries, "Americanism," movie reviews, restaurant reviews, television shows, and other sources, court found "Toll House" generic as matter of law for cookies).

### 2. A Grant of a Renewed Motion for Summary Judgment is Proper

Equally flawed is Nartron's contention that because its evidence was sufficient to defeat ST's initial motion for summary judgment then, *a fortiori*, it had to be sufficient to defeat ST's Renewed Motion.

It is well established that "a court may entertain a successive summary judgment motion, particularly when the defendant has expanded the factual record on which summary judgment is sought." *Gulezian v. Drexel Univ.*, 1999 U.S. Dist. LEXIS 4624 (E.D. Pa. 1999) (citing cases). As one Sixth Circuit judge aptly explained:

> Another problem with [the *Avery Dennison* case] is its assumption that a district court's denial of

summary judgment is entitled to preclusive effect, as if it becomes "the law of the case." It does not. *See, e.g., Perez-Ruiz v. Crespo-Guillen*, 25 F.3d 40, 42 (1st Cir. 1994) (noting that interlocutory orders do not become "the law of the case" and "remain open to trial court reconsideration"); *Dessar v. Bank of Am. Nat'l Trust & Sav. Ass'n*, 353 F.2d 468, 470 (9th Cir. 1965) (observing that the denial of a motion for summary judgment "merely postpones decision of any question; it decides none" and that "to give it any other effect would be entirely contrary to the purpose of the summary judgment procedure. The court did nothing more than it purported to do, that is, refuse to grant the motion"); *Dictograph Prods. Co. v. Sonotone Corp.* 230 F.2d 131, 134-35 (2d Cir. 1956) (L. Hand, J.) ("No one will suggest that the [trial judge] may not change his mind and overrule his own order. . . . 'In the absence of statute, the phrase, "law of the case," as applied to the effect of previous orders . . . merely expresses the practice of courts generally to refuse to reopen what has been decided, not a limit on their power.'") (quoting *Messenger v. Anderson*, 225 U.S. 436, 444 (1912) (Holmes, J.)).

District courts may in their discretion permit renewed or successive motions for summary judgment, particularly when the moving party has expanded the factual record on which summary judgment is sought. *See, e.g., Whitford v. Boglino*, 63 F.3d 527, 530 (7th Cir. 1995) ("The denial of summary judgment has no res judicata effect, and the district court may, in its discretion, allow a party to renew a previously denied summary judgment motion or file successive motions, particularly if good reasons exist."). If the denial of a motion for summary judgment were entitled to preclusive effect, district courts presumably

would not be allowed to entertain renewed or successive summary judgment motions.

*Kovacevich v. Kent State Univ.*, 224 F.3d 806, 835 (6th Cir. 2000) (Gilman, J. concurring).

The expanded, detailed, and undisputed record supporting ST's Renewed Motion for Summary Judgment compelled the conclusion that there was no genuine issue of material fact on whether "smart power" was generic in the semiconductor industry. Nartron has conspicuously ignored this expanded record which included:

a. **The Chronology:** While some of the individual materials contained in the Chronology were referenced in the initial summary judgment motion, there was a substantial amount of new material (including, for example, 60 seminars and symposia devoted to "smart power;" semiconductor company advertisements for their "smart power" products; hundreds of additional trade journals and publications referencing "smart power;" and dozens of additional patents). In addition, the district court was, for the first time, provided with a detailed twenty-year history of this constant industry use of "smart power" as a generic term. The Chronology also included countless industry publications that expressly concluded that "smart power has become generic." For example:

   - Spring 1987, Proceedings of the Symposium on High Voltage and Smart Power Devices: "SMARTPOWER has become a generic term for a wide range of products and technologies all of which implement the function of interfacing logic circuits to power loads." (JA 951-960).
   - *Electronic Engineering Times*, "Power Technologies" (Sept. 28, 1987): After first being used by Motorola, Smart Power

"now . . . has become a generic term." (*Id.* at 917).

- *Electronic Engineering Times*, "The Ongoing Saga of 'Smart' Power" (April 29, 1991): "Smart power as a generic term began in 1980 and, by 1983, had earned widespread acceptance." (*Id.* at 1141-1142).
- *Electronic Engineering Times* (July 10, 1995), entitled "ICs Shake Off 'Bad Rap' to Offer Cost, Functionality Advantages – A Newer More Intelligent Smart Power," the author stated that: "The problem with the so-called smart-power concept is that it is so generic." (*Id.* at 922-924).
- Even a May 1992 Patent explained that there "have been proposals to provide technologies which combine digital logic with high-current switching capability. Such technologies have been promoted under the buzzword of 'smart power' technologies." (*Id.* at 1029).

**b. Undisputed testimony from representatives of the semiconductor industry**: For example:

- David Tam (International Rectifier) – When asked at his deposition, "Based on your experiences in the semiconductor industry . . . how do you understand your customers to use the term 'smart power?'" he answered, "*Generic meaning . . . to mean power devices that have control circuit.*" (JA 860). When asked, "Are you aware of any of your customers who use smart power to identify a particular manufacturer?" he answered, "No." (*Id.* at 861). And when asked, "Why can't you identify the manufacturer of an integrated circuit from being told it's a smart

power?" he answered, "Everybody uses the term." (*Id.* at 861).

- Thomas Tobin (Infineon) – When asked, "How do you understand the term smart power to be used in the trade or technical press articles you have seen . . . ?" he replied, "*They tend to describe it for the technologies which we had discussed. Normally generically, not assigned to any particular company, but basically the technology employed.*" (JA 864). He also said, "I haven't seen them [semiconductor industry members] write it or refer to that technology [referring to "smart power"] and attribute it to a particular manufacturer." (*Id.* at 865).
- Jack Gardner (Arrow) – "*[The term 'smart power' is used] widely in the industry to define a combination of a discreet power component and a logic IC.* . . . I have seen it used in a number of places, in open conversations with customers, with our suppliers as well as in written documentation." (*Id.* at 823). When asked, "If a customer asked you to purchase them a smart power chip, do you know what source they're asking you to buy from," he answered, "No, absolutely not." (*Id.* at 824). When asked, "How common is the use of smart power as a description of this chip in the industry in which you work?" he answered, "Very common." (*Id.* at 825). And during the past 20 years of his involvement in this industry, he was not aware of Nartron using the term smart power in any way. (*Id.*).
- David Stein (Future Electronics) – "*To me 'smart power' is a generic term used to*

*describe a situation where you integrate logic devices on the same substrate with power semiconductors. . . .* " (*Id.* at 1160).

c. **Materials pertaining to ST's VIPower® products:** The expanded recorded also included numerous marketing materials utilizing "smart power" to describe the technology in ST's VIPower® products (*e.g.*, datasheets describing the products as containing "HIGH SIDE SMART POWER SOLID STATE RELAY"). (*Id.* at 516).

It is difficult to imagine a case that involves more undisputed evidence from the relevant public than that presented by ST in its Renewed Motion for Summary Judgment.

## B. ST Was Entitled To Summary Judgment Because There Was No Genuine Issue Of Material Fact As To Whether "Smart Power" Is Generic

### 1. Summary Judgment Standard

Summary judgment is appropriate where there is no genuine issue of material fact, and the moving party is entitled to judgment as a matter of law. FED. R. CIV. P. 56. The moving party bears the initial responsibility of identifying an absence of a genuine material issue. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The nonmoving party then must designate specific facts showing that there is a genuine issue for trial. *Id.* at 324. Rule 56 requires entry of summary judgment against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. *Id.* at 322. Where the opposing party bears the burden of proof at trial, its evidence must meet the quantum of proof at trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 252 (1986).

Moreover, "only disputes over facts which might affect the outcome of the suit under the governing law will properly preclude entry of summary judgment. Factual disputes that are irrelevant or unnecessary will not be counted." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A non-moving party must "do more than simply show that there is some metaphysical doubt as to the material facts." *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586-87 (1986).

The Sixth Circuit repeatedly – and properly – found that applying this standard to the undisputed record before it entitled ST to summary judgment.

### 2. ST Satisfied its Burden of Establishing that "Smart Power" is Generic in the Semiconductor Industry

Nartron does not challenge the Sixth Circuit's ruling regarding the test for determining whether "smart power" is generic:

> "A generic term is one that is commonly used as the name of a kind of goods. . . . Unlike a trademark, which identifies the source of a product, a generic term merely identifies the genus of which a particular product is a species." If a mark's primary significance is to describe a type of product rather than the producer, it is generic and is not a valid trademark. *Thus, the appropriate "test for genericness is whether the [relevant] public perceives the term primarily as the designation of the article."*. . . . Thus, there can be no infringement if the primary significance of "smart power" as used by ST is to describe a type of product, here a type of technology, and *not* to identify the source of such products.

Pet. App. at 11a (citation omitted). The court further explained that "the 1984 'Anti-Monopoly' amendments to

the Lanham Act require that 'the primary significance of the registered mark to the *relevant* public . . . shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it is used." *Id.* at 14a (citing 15 U.S.C. §1064(3) (emphasis in original).

In determining the reaction of the "relevant public" – here the semiconductor industry – evidence "may be obtained from *any competent source*." *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1570 (Fed. Cir. 1987). This includes such sources as dictionary definitions, newspapers and other publications, generic use by competitors, generic use of the term by the mark's owner, and use of the term by third parties in trademark registrations. *See* Pet. App. at 15a (citing cases). As the Sixth Circuit stated, "ST did just that." *Id.*

In addition to the unrebutted admissions from the semiconductor industry (*i.e.*, manufacturers, customers, suppliers, vendors) that "smart power" is generic, ST also presented its 150-page Chronology from 1982 through mid-2000 that digested the following pervasive uses of "smart power" (based on the categories identified in the case law):

- **Trade Journals, Newspapers, and Other Publications** – *Hundreds* of articles and press releases refer to "smart power" to identify technology or devices, particularly ICs, that combine both power and logic. *See Pilates, Inc. v. Current Concepts, Inc.*, 120 F.Supp.2d 286, 300 (S.D.N.Y. 2000) (newspaper and magazine use of a term in a generic sense is strong evidence of genericness); *CES Publ'g Corp. v. St. Regis Publ'g*, 531 F.2d 11, 13 (2d Cir. 1975) (articles and advertisements show that "consumer electronics" is generic); *Nestle Co.*, 571 Supp. at 763 (use in cookbooks,

publications, restaurant reviews, and on television demonstrate that "toll house" is generic). *See* examples at JA 926-944 and *supra* at p. 5 (*e.g., Smart Power Economics, Technology and Applications*, a 700-page book, ©1988, containing 80 articles devoted to "smart power").

- **Conference Materials** – Over 60 conferences and seminars have involved topic discussions or articles on "smart power" which identify a type of IC or technology combining power and logic. *See supra* at p. 5 and examples at JA 962-981.
- **Advertisements** – At least 20 semiconductor companies have referred to "smart power" in their advertisements to identify a type of IC or technology combining power and logic. *See supra* at p. 5 and examples at JA 1005-1025.
- **U.S. Patents** – Over 200 U.S. patents use "smart power" to identify a type of IC or technology combining power and logic. Such use in as few as *three* patents has been held to show genericness. *See Liquid Controls*, 802 F.2d at 938. *See also supra* at p. 5 and examples at JA 1044.
- **U.S. Trademark Registrations** – Two U.S. trademark registrations (JA 1049-1052) use "smart power" to identify an application for semiconductor devices. This suggests that even the PTO now views "smart power" as a type of technology, rather than a source designation. *See Frito-Lay, Inc. v. Bachman Co.*, 704 F. Supp. 432, 440 (S.D.N.Y. 1989) (use in trademark registrations evidences genericness).

- **U.S. Copyrights** – The Copyright Office has registered claims for at least five text applications and several mask works using "smart power" in the title. (JA 1054-1059).

In light of this record, the Sixth Circuit had overwhelming reasons to "agree with the district court that ST produced enough evidence to overcome the presumption of non-genericness." Pet. App. at 15a.

### 3. Nartron's Criticisms of the Sixth Circuit's Ruling Have No Merit

Nartron identifies no circuit or other court-split resulting from the Sixth Circuit's ruling and no constitutional or federal law issue of paramount importance. Instead, Nartron is basically seeking *de novo* review by this Court of a court of appeals' opinion that it does not like. Even assuming this was adequate under Supreme Court Rule 10 – which it obviously is not – Nartron's allegations of error are disposed of easily.

First, Nartron contends that the "evidence" it presented in opposition to ST's initial motion for summary judgment was sufficient to defeat ST's Renewed Motion. According to Nartron, this consisted of: Nartron's advertising and sales figures; a single editorial from a trade journal; the declaration of Nartron's President; and the absence of "smart-power" from any technical dictionaries. Each of these fail for the following reasons:

- Nartron's financial information is obviously not evidence of how the relevant consuming public interprets the term "smart power" and does nothing to rebut the evidence presented by ST. Nartron never presented any evidence that, as a result of its expenditures, the semiconductor industry associates "smart power" with Nartron.

- The impetus for the 1991 editorial in the trade magazine indicating that "Smart Power" is a Nartron trademark was the author's explicit recognition that "smart power" was on the verge of becoming a generic term in the semiconductor industry. Moreover, given that "the record before [the Sixth Circuit was] replete with evidence submitted by ST in support of its claim that 'smart power,' as used in connection with its VIPower® line of products, is perceived as a generic term by participants in the semiconductor industry including manufacturers, customers, suppliers, vendors and the trade and technical press," (Pet. App. at 14a), this sole editorial was hardly sufficient to create a genuine issue of material fact for a jury.
- The self-serving Declaration from Nartron's President that Nartron has always used "smart power" as a trademark is also not evidence from the relevant consuming public. In fact, this says nothing about how the semiconductor industry uses the term. Moreover, "on summary judgment, a plaintiff cannot rely upon conclusory statements in affidavits or in his own deposition testimony. Rather, a plaintiff must support his contentions with proper documentary evidence." *S Indus., Inc. v. GMI Holdings*, 1998 U.S. Dist. LEXIS 1780 (N.D. Ill. 1998) (*citing Celotex Corp.*, 477 U.S. at 324).
- As the Sixth Circuit correctly ruled, "Nartron's reliance on ST's failure to provide any dictionary containing a definition for 'smart power' is misplaced. Dictionary definitions are merely one source from which genericness may be proven. The law is quite clear that the absence of a composite term from the dictionary does not end the analysis,

> because numerous terms have been found to be generic despite their absence from the dictionary. *See, e.g., Liquid Controls*, 802 F.2d at 937 (holding that "liquid controls" is generic); *National Conf. of Bar Examiners v. Multistate Legal Studies*, 692 F.2d 478, 487-88 (7th Cir. 1982) (holding that "multistate bar examination" generic); *Technical Publishing Co. v. Lebhar-Friedman, Inc.*, 729 F.2d 1136, 1139 (7th Cir. 1984) (finding that "software news" probably generic); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 56 F.2d 75 (7th Cir. 1977) (holding that "light beer" is generic), *cert. denied*, 434 U.S. 1025 (1978)." Pet. App. at 16a-17a.

Second, Nartron mischaracterizes ST's Chronology as an "amalgam of alleged uses of the words 'smart' and 'power' " that merely shows "smart power" is being used in a descriptive manner. (Pet. App. at 15). "Nartron fails to appreciate the distinction between 'common descriptive' terms and terms considered 'merely descriptive.' Some terms on ST's list . . . suggest that 'smart power' was being used descriptively. The majority of the examples, however, clearly demonstrate that, as used in the semiconductor industry, 'smart power' was used as the designation of the article itself – here, a wide range of products and technologies all of which implement the function of interfacing logic circuits to power loads." (*Id.* at 18a). In addition to the wealth of examples explicitly stating that "smart power" is generic (*supra* at 18-19), some others vividly illustrating this point include:

- ST's *Smart Power Application Manual* (JA 1107).
- A December 1986 article in *PCIM* entitled, "*SmartPower: Its Time Has Come.*" (*Id.* at 930).

- *Electronic Engineering Times* article entitled, *"The Ongoing Saga of 'Smart' Power."* (April 29, 1991) (*Id.* at 919).
- A press release referring to Motorola, Inc. as "the market leader in smart power," that "will preview its latest smart power capabilities, as well as its next generation . . . smart power technology." (*Id.* at 947).

Just these few illustrative examples eviscerate Nartron's contention that there is no evidence that the semiconductor industry refers to or asks simply for "smart power."

## CONCLUSION

Nartron claims it is entitled to review on certiorari because it "submitted substantial evidence that its 'SMART-POWER' mark is not generic, and that evidence bars summary judgment." This contention, however, alleges no conflict with the decisions of this Court or any other court, nor does it raise an issue having any significance beyond this individual case. Moreover, the allegation is simply incorrect. Nartron produced no evidence to counter the overwhelming evidence presented by ST, and thus, there was nothing for the Sixth Circuit to weigh. To the contrary, as conclusively established throughout the 150-pages of ST's Chronology documenting the pervasive use in the semiconductor industry, "smart power" is plainly generic. Accordingly, in its thorough and thoughtful Opinion, the Sixth Circuit properly held that:

> Here, on its summary judgment motion for genericness, ST sufficiently carried its burden of demonstrating the absence of any genuine issue of material fact on its claim of genericness. ST produced overwhelming evidence, which Nartron failed to rebut, that the term "smart power," as

used by ST and other participants in the semiconductor industry, denotes a type of technology, *not* goods associated with Nartron.

* * *

ST provided undisputed deposition testimony from third-party participants in the semiconductor industry, including manufacturers and distributors. They provided testimony that manufacturers, customers, suppliers, vendors, and others in the semiconductor industry, including the trade and technical press, use the term "smart power" generically to mean power devices that have control circuits. In addition to unrefuted admissions by professionals in the semiconductor industry that "smart power" is generic, ST also prepared a 150-page chronology from 1982 through the present that digested the pervasive uses of "smart power" to identify devices that utilize a certain type of technology, particularly integrated circuits that combine both power and logic. This chronology provided evidence from a variety of sources including trade journals, newspapers and other publications, and advertisements. In addition, the chronology also set forth evidence from patent, trademark and copyright registrations indicating that even the United States Patent and Trademark Office and the United States Copyright Office have come to recognize the term as signifying a type of technology in the semiconductor industry. Thus, the overwhelming evidence in this case obviates the need for ST to have conducted a consumer survey. This result is compelled where Nartron has failed to rebut the proffered evidence, nor provided evidence of its own suggesting that there is a genuine issue of material fact with respect to the issue of genericness.

(Pet. App. at 12a, 15a) (citations omitted).

For the reasons stated, Nartron's suggestions that the Sixth Circuit wrongly decided the appeal and that this Court should review this interesting, but unremarkable, trademark case are both wrong. Nartron's Petition should be denied.

Respectfully submitted,

BUTZEL LONG
PHILIP J. KESSLER
*Counsel of Record*
JAMES E. STEWART
LAURIE J. MICHELSON
150 West Jefferson, Suite 900
Detroit, MI 48226-4430
(313) 225-7000

THOMPSON & KNIGHT L.L.P.
BRUCE S. SOSTEK
JANE POLITZ BRANDT
1700 Pacific Avenue, Suite 3300
Dallas, TX 75201-4693
(214) 969-1700

*Counsel for Respondent*

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